

REMARKS

Applicants respectfully request reconsideration of the instant application in view of the foregoing amendments and the following remarks. Claims 18-19, 24-29, 60-69, and 71-97 are pending in this application. Claims 98 and 99 are added herein. Claims 60-65 and 69 have been amended herein. Applicants submit that the support for new claims 98 and 99 and the amendments for amended claims 60-65, 69, 71, 74, 75, 80 and 81 may be found throughout the specification and that no new matter is added by way of this amendment.

Claim Rejections - 35 USC § 112

Claims 18-19, 27-29, 60-69, 75, 80-81, 86-90, 92, 93-95 and 97 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants respectfully traverse the § 112, second paragraph, rejection. More specifically, Applicants submit that these claims have been substantively examined several times and this is the first instance of a 112 rejection alleging that claims are "unclear." More specifically, it is alleged in the pending Office Action that it is "unclear how the phrase ['without consideration of individual characteristics of the buyer or the lessee'] is intended to modify these claims" (See, Office Action dated November 16, 2006, page, 2, ¶5). Applicants request clarification as to why any claim elements that were "unclear" have not been previously identified and addressed in any previous Office Action or during any in-person or telephonic Examiner interviews.

As such, Applicants submit that that the pending claims are clear, unambiguous and definite within the context of 35 U.S.C. § 112. Applicants submit that the claims should be

examined in light of the specification. Accordingly, Applicants submit that the specification provides support and discussion of non-limiting examples of how the various systems and methods described in the application may be configured for providing an insurance policy with a premium that is determined "without the consideration of individual characteristics of the buyer or lessee" as recited in the various pending claims identified above.

Claims 60-65, 69, 71, 74, 75, 80 and 81 have been amended herein to remedy informalities associated with antecedent basis.

If the Examiner maintains this rejection, Applicants request additional clarification regarding how the claim elements are allegedly "unclear" and indefinite. Accordingly, Applicants request withdrawal of this ground of rejections

Claim Rejections - 35 USC § 103

Claims 18-19, 24-29, 60-69, and 71-97 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Osborn, et al. (US Patent No. 6,182,048) (hereafter "Osborn"), in view of Thomson, et al. (US Published Patent Application No. 2003/0061104) (hereafter "Thomson"). Applicants respectfully traverse these rejections and request reconsideration in view of the above amendments and the following discussion.

I. Claims 18-19, 24-29, 60-69, and 71-97 are Patentably Distinct from Osborn, in view of Thomson

Applicants submit that neither of the cited references considered alone, in combination, or in light of the prior art establish a prima facie case of obviousness with regard to at least several aspects of the pending claims.

A. Independent claims 18-19, 27-29, 60-69, 75, 80-81, 86-90, 92-95 and 97 are patentably distinct from the cited references.

Applicants submit that the cited references discuss determining a warranty policy price based on a risk-based purchaser characteristic assessment (as in Osborn) and a warranty policy administration system (as in Thomson). Accordingly, Applicants submit the references taken alone or in combination do not render obvious at least this aspect of independent claim 18 or the other independent claims identified above.

Independent claims 18-19, 27-29, 60-69, 75, 80-81, 86-90, 92-95 and 97, each include a claim element reciting "**without consideration of individual characteristics of the buyer or lessee**" as in independent claim 18 or a variant thereof.

For example, Applicants note that claims 18, 19, 27-29, 61-69, 75, 80, and 81 include an element(s) directed to determining, calculating, or charging an insurance premium based on a "class of items;" a "geographic region" and "without consideration of the individual characteristics of the buyer or lessee." The other claims in Group I include variations of "individual characteristics." For example, Claims 86-88, 92-94 and 97 recite the phrase "without consideration of the individual statistics associated with the buyer or lessee." Claims 89 and 95 recite "without considering at least a driving history of the buyer or lessee", whereas independent claim 90 recites, "without consideration of the age of the buyer or lessee."

With regard to independent claim 18, the Examiner alleges Osborn, discusses, "the premium [is] based on a class of the item and a geographic region of the buyer or lessee without consideration of individual characteristics of the buyer or lessee (See Osborn, Col. 1, lines 53-65)." (See, Office Action, page 4, ¶1).

However, Applicants submit that Osborn discusses a system for pricing and administering warranties that facilitates a risk factor pricing determination for an individual. More specifically, Osborn's system facilitates an analysis of characteristics associated with the product and the purchaser to determine whether the purchaser is a high-risk or low risk purchaser. Based on this determination, Osborn can then charge a higher or lower premium for the warranty policy.

For example, Osborn's system determines the warranty policy price by calculating a series of "risk factors" (similar to the "risk rating" discussed in Fig. 1 'prior art' insurance policy from the instant application) (See, Osborn, Col. 1, lines 45-50). However, Applicants note that Osborn uses the geographic and environmental data to supplement the individual purchaser data used for determining the purchaser's risk factors and ultimately the warranty policy price. The risk-based individual purchaser data determination incorporates data from historical policy characteristics (See, Osborn, Col. 8, Lines 26-65); item-specific characteristics, such as types of vehicle components (See, Col. 7, lines 32-Col. 8, line 27) and individual characteristics associated with a purchaser and purchased item including factors such as the vehicle's mileage and/or the Vehicle Identification Number. (See, Osborn, Col. 1, lines 55-59; Col. 5, lines 1-5) in making the risk determination.

Applicants submit that Thomson fails to remedy at least this deficiency with regard to the pending claims. Thomson (¶ 0015 and ¶0117), simply describe aspects of a

warranty administrator support system facilitating online communication between customers, sellers (e.g., retailers), the manufacturer and a warranty administrator. Thomson (§ 0086-0092) also discusses aspects of communication between entities and other services/functionality that may be coordinated by a warranty administrator including providing product shipping (See, § 0089), providing consulting services that analyze product trends (See, § 0090) and/or coordinating offering an insurance policy to cover theft, loss, damage or obsolescence of the product. (See, § 0090).

However, Applicants submit that Thomson's discussion of a warranty administrator coordinating a user obtaining an insurance policy in addition to a warranty policy does not remedy the deficiencies discussed above with regard to Osborn and the pending claims. Thomson's discussion of this type of supplemental service is brief and is silent as to how the insurance policy premiums are determined. More specifically, Applicants submit Thomson does not provide a basis for determining a premium based on a class of an item, a geographic region, and without considering the individual characteristics of the buyer, as recited in independent claim 18.

Accordingly, Applicants submit that the combination of Osborn's purchaser risk-factor based pricing determination with Thomson's general warranty information dissemination system does render obvious the elements recited in the pending claims. For at least this reason, Applicants request withdrawal of the rejections of claims 18-19, 27-29, 60-69, 75, 80-81, 86-90, 92-95 and 97, as well as the claims directly or indirectly dependent therefrom.

B. Claims 24-26, 91 and 96 are Patentably Distinct From the Cited

References

Applicants submit that the claims 24-26, 91, 96 are also patentably distinct from the cited references, taken alone, in combination, or in light of the scope and content of the prior art. Independent claims 24-26, respectively recite, "an indication of a class of items for which insurance is to be provided to a buyer or lessee residing in a geographic region...and confirming the buyer or lessee resides in the geographic region." Similarly, claims 91 and 96 recite, calculating an offer price for an:

insurance policy based upon (1) the class of vehicle to be leased or purchased and (2) a geographic region in which a potential buyer or lessee resides; and subsequently confirming that said buyer or lessee resides in the geographic region; and providing said insurance policy to said buyer or lessee.

In contrast to Osborn's purchaser risk-pricing warranty policy may incorporate geographic data into a risk characteristic used to determine the price of a warranty policy. However, Applicants submit Osborn's purchaser risk-pricing warranty policy determination based in part on geographic data is not analogous to providing insurance for a specific class of item, confirming that the buyer resides in the geographic region, and providing an insurance policy to a particular buyer or lessee residing in the geographic region, as recited in the claims.

Further, Applicants submit that Thomson does not remedy at least this deficiency regarding claims 24-26 or claims 91 and 96. More specifically, Applicants submit that Thomson's warranty administration system does not discuss providing insurance for a specific class of item/vehicle, insuring a buyer/lessee in the geographic region and confirming that the buyer resides in the geographic region before providing an insurance policy to a particular buyer or lessor residing in the geographic region or provide a basis for a predictable variation that would result in the claimed invention.

As discussed above, Thomson indicates that a manufacturer may include insurance for covering the theft, loss, damage or obsolescence. However, there is no discussion in Thomson about providing an insurance policy for a particular class of items (claims 24-26) or a class of vehicle (claims 91, 96) for a buyer residing in a geographic region as recited in claims 24-26, 91 or 96, respectively. For at least this reason, Applicants request withdrawal of the rejections of claims 24-26, 91 and 96.

C. Claims 71 and 74 claims are patentably distinct from cited references

Applicants submit that the Group Claims 71 and 74 are also patentably distinct from the cited references, taken alone, in combination, or in light of the scope and content of the prior art. Independent claims 71 and 74, respectively recite an element directed to "providing ... a paid insurance policy including at least minimum insurance required of the buyer or lessee for the geographic region."

Applicants submit that Osborn's purchaser risk-based warranty pricing determination or Thomson's warranty administration system do not discuss providing an insurance policy that provides the minimum insurance required for a region that would render obvious the claim element. As discussed above, Osborn discusses incorporating geographic data and environmental data with the purchaser's item-specific and individual characteristics to determine an individual's risk characteristics. Based on the risk determination of the individual, Osborn's system determines the price of a warranty policy. Accordingly, Applicants submit that Osborn's risk-based pricing is unrelated to providing the minimum insurance required for a geographic region (e.g., New York state may require automobile owners to have certain

minimum levels of different types of insurance in order to buy/register an automobile within the state).

Similarly, Thomson fails to remedy Osborn's deficiencies. Thomson discusses an ancillary system support service whereby insurance may be provided to cover the theft, damage, or obsolescence of the item covered by a warranty. However, there is no discussion in Thomson about providing insurance policy coverage for at least a minimum insurance coverage required for the geographic region, as recited in claims 71 and 74 or claims 72 or 73, which depend on independent claim 71. For at least this reason, Applicants request withdrawal of the rejections of claims 71-74.

Accordingly, Applicants submit that the claims 18-19, 24-29, 60-69, and 71-97 are patentably distinct from the cited references taken alone or in combination for at least these reasons. For at least this reason, Applicants request withdrawal of these grounds of rejections.

Furthermore, Applicants submit that new claims 98 and 99 are patentably distinct from the cited references, taken alone or in combination for at least reasons similar to those discussed above.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 18-19, 24-29, 60-69, and 71-99, all:

overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17246-004.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17246-004.

Respectfully submitted,
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